

Office Action Summary

Application No.

09/509,301

Applicant(s)

WILLIAM, HAROLD JAY

Examiner

Chester T. Barry

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claims 1 – 12 are rejected under 35 USC 35 U.S.C. Sec. 102(b) as anticipated by WO 94/00237 to Monash University (published 6 January 1994)(hereinafter "Lawson").

Lawson describes a material comprising an ion exchange material dispersed or distributed within a polyurethane polymer. The polyurethane polymer may be swollen by toluene (page 7 line 36). Accordingly, given the broadest reasonable construction of the claims that is not inconsistent with the specification, Lawson's material is "superabsorbent."

Also, there does not appear to be any indication in Lawson – or elsewhere on this record – that a polyurethane foam capable of absorbing toluene cannot also absorb water notwithstanding the widely recognized nature of toluene as a hydrophobic organic solvent and water as a hydrophilic aqueous solvent. That is, there is no indication on this record that the Lawson polyurethane foam cannot absorb hydrophilic water as well as a hydrophobic organic solvent, such as toluene.

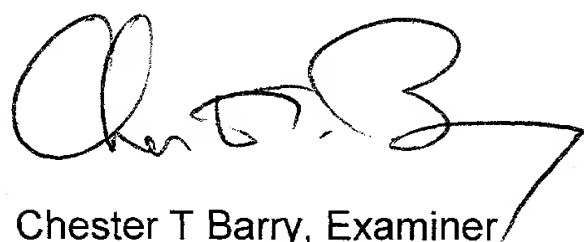
USP 5838863 at col 11 line 65+, USP 5104909 (entire document), and JP 2-140216 are cited to show that polyurethane foams are widely recognized as being water absorbent.

Claims 1 – 12 are rejected under 35 USC §112(2nd) as failing to particularly point out and distinctly claim the subject matter for which patent protection is sought. The distinction, if there is one, between the Lawson disclosure and the invention of at least

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claims 1 and 6, lies in a reasonably precise understanding of the distinction between a "superabsorbent" polyurethane foam and other polyurethane foam materials that are not fairly characterized as "superabsorbent." The art of record does not appear to provide a reasonably precise standard by which this distinction may be made with a reasonable degree of certainty. Applicant's specification does not provide a reasonably clear definition of what applicant regards as a "superabsorbent" polymer in terms that provide the public with fair notice of the metes and bounds of the claimed subject matter.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



Chester T Barry, Examiner

703-306-5921



A DOCPHOENIX

OUTGOING

CTMS
 Miscellaneous Office Action
IMIS
 Miscellaneous Internal Document
NRES
 Letter Restarting Period for Response
 1449
 Signed 1449
 892
 892
 ABN
 Abandonment
 APDEC
 Board of Appeals Decision
 APEA
 Examiner Answer to Appeal Brief
 CRFR
 Letter Requiring CRF
 CTAV
 Count Advisory Action
 CTEQ
 Count Ex parte Quayle
 CTFR
 Count Final Rejection
 CTNF
 Count Non-Final
 CTRS
 Count Restriction
 EXIN
 Examiner Interview
 FOR
 Foreign Reference
 M903
 DO/EO Acceptance
 M905
 DO/EO Missing Requirement

OUTGOING

NFDR
 Formal Drawing Required
 NOA
 Notice of Allowance
 NPL
 Non-Patent Literature
 PEFN
 Pre-Exam Formalities Notice
 PETDEC
 Petition Decision
 ANE.I
 After Final or 312 Amendment

PTO INTERNAL

CLMPTO PTO Prepared Complete Claim Set	SRNT Examiner Search Notes	SEQREQ Sequence Problem Att from Examiner
IIFW File Wrapper Issue Information	SRFW File Wrapper Search Info	CDCHECK Compact Disk Review Checklist